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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,303	10/03/2000	Louis-Phillippe Vezina	14149-4 "US" FC/ntb	5731

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EXAMINER

HELMER, GEORGIA L

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 06/03/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/678,303

Applicant(s)

VEZINA ET AL.

Examiner

Georgia L. Helmer

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17 2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 1638

## **DETAILED ACTION**

### ***Status of the Claims***

1. The Office acknowledges receipt of Applicants Response; dated 26 March 2003, paper number 16.
2. Applicant has cancelled claims 3 and 4, and amended claims 1, 2, and 5. New claims 9 and 10 have been added. Claims 1,2, and 5-10 are pending. Claims 1, 2, 5, 9 and 10 are examined in the instant action.
3. This application contains claims drawn to an invention nonelected with traverse in Paper No. 12, dated 21 October 2002. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
4. All rejections not addressed below have been withdrawn.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Specification***

6. The first line of the specification is objected to because it recites the serial number of the present application, while stating that this application is a continuation of the same. Correction is required.

Applicant traverses, stating primarily that the version of the application in their hands does not contain an incorporation by reference mentioning a serial number. And that Examiner must have another versions of the application . Applicant requests

Art Unit: 1638

Examiner to send a copy of his version so as to enable corrections to the specification.

Applicant's traversal has been considered and is unpersuasive because the language at issue is present in the Preliminary Amendment, paper No. 4, filed 1 March 2002.

Applicant has requested amending the application by replacing the paragraph line I of page 5 with an amended paragraph. However the amended "paragraph" is not a paragraph, just a part of a paragraph. This amendment is objected to under 37 CFR 121(b), which states that such amendments need to be of complete paragraphs. This amendment has not been entered and Applicant should resubmit it in proper form.

***Claim Rejections - 35 USC § 112, second paragraph***

7. Claims 1,2, 5, 9, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "the" needs to be inserted between "consisting of" and "sequences set forth". Otherwise the claim is indefinite and reads on pieces of the complete SEQ ID Nos.

In claim 2, "the" needs to be inserted between DNA of interest by" and "presence" for clarity. Also, "presence of light" implies all light conditions of all magnitudes and wavelengths.

***Claim Rejections - 35 USC § 112, first paragraph***

***Enablement***

8. Claims 1,2, 5, 9, and 10 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection is maintained for reasons of record.

Applicant traverses, stating primarily that from the disclosure, it is shown how to prepare the expression vectors, that someone skilled in the art would easily perform the protocol described by the manufacturers specification. And that someone skilled in the art having the plasmid pGPLAS3.2 in his hands would recognize that it results from the integration of SEQ ID NO: 1 into the cloning vector pGEM/T which is a vector provided by Promega.

Applicant's traversal has been considered and is unpersuasive because no description of pGPLAS3.2 has been provided, nor is information about what DNA sequences, in what configuration, of what length, and in what orientation are present in the plasmid. Neither the specification nor the Declaration of Dr. Marc-Andre Daoust, dated 21 February 2001, provides this information.

Art Unit: 1638

Applicant traverses, stating primarily the Declaration of Dr. Marc-Andre Daoust, dated 21 February 2001, as well as the results described in the present application show that the promoter described in SEQ ID NO: 1, and fragments thereof, namely P960 and P729, which are respectively SEQ ID NO: 2 and 3, are active in inducing the transcription of the  $\beta$ -Glucuronidase marker genetically transformed plant cells.

Applicant's traversal has been considered and is unpersuasive because the starting materials for the experiments described in the Declaration-- the specific DNA delivered, the specifics of the DNA constructs, what sequences and genes are involved, whether an expression cassette or vector is involved, are not described other than citing "the P960 deletion". No information is given on the relationship of the specifics of the Declaration to the claimed invention. What is P970? What is pGPLAS3.2? How do these relate to the claimed invention?

Applicant traverses, stating primarily that one skilled in the art will understand that Applicants do not claim plants or plants cells in which the promoters of the present invention do not work. And that also, it is well known in the art that the use of a promoter originating from one group of organism, such as dicots, can be successfully used in other groups, such as monocots or vice versa.

Applicant's traversal has been considered and is unpersuasive for reasons of record, re-cited below:

Art Unit: 1638

Applicant is not enabled for all plant cells, or for the broad scope of the claims. This is because using a promoter isolated from one species of plant would produce unpredictable results when said promoter is used to specify expression of a gene in another species of plant. Oommenn et al (1994, The Plant Cell 6:1789-1803) teach that the alfalfa isoflavone reductase promoter exhibits a different expression pattern in tobacco as compared to the expression in alfalfa. In tobacco, the alfalfa isoflavone reductase promoter expressed in vegetative tissues and in reproductive organs whereas the same construct only expressed in the root meristem, cortex and nodules of alfalfa plants (abstract).

***Remarks***

9. No claim is allowed.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

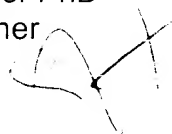
Art Unit: 1638

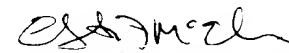
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 703-308-7023. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 703-306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Georgia Helmer PhD  
Patent Examiner  
Art Unit 1638  
May 30, 2003



  
ELIZABETH F. McELWAIN  
PRIMARY EXAMINER  
GROUP 1800